Remarks

1. Summary of the Office Action

In the final office action mailed February 1, 2008, the Examiner rejected claims 1-20 under 35 U.S.C. § 101 on grounds of allegedly being directed to non-statutory subject matter. Further, the Examiner rejected claims 1-2, 4-8, 11-15, and 17-25 under 35 U.S.C. § 103(a) as being allegedly obvious over U.S. Patent No. 6,845,152 (Taff) in view of U.S. Patent No. 6,373,930 (McConnell), the Examiner rejected claims 3 and 16 under 35 U.S.C. § 103(a) as being allegedly obvious over Taff and McConnell in view of U.S. Patent No. 7,263,354 (Naim), and the Examiner rejected claims 9 and 10 under 35 U.S.C. § 103(a) as being allegedly obvious over Taff and McConnell in view of U.S. Patent No. 6,963,583 (Foti).

2. Status of the Claims

Pending are claims 1-25, of which claims 1, 14, and 21 are independent and the remainder are dependent.

3. Response to § 101 Rejections

The Examiner rejected claims 1-20 as being allegedly directed to non-statutory subject matter, on grounds that the specification states that that the method may be implemented in the form of software. First, the recited portion of the specification (page 10, lines 19-21) refers merely to SCP service logic. Second, the fact that the specification notes that the SCP service logic can be implemented as machine language instructions in the form of software clearly does not mean that the invention as recited by claims 1-20 should be interpreted as software *per se*. Third, even if the method claims could be interpreted as involving software-based functions, the claims are still directed to statutory subject matter, as the claims clearly recite machine-implementation or physical transformation, at a minimum because the claims recite functions

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such as (i) directing a switch to set up a call to a subscriber station and (ii) setting up a call to a subscriber station.

Because claims 1-20 recite statutory subject matter, Applicant requests withdrawal of the § 101 rejections.

4. Response to § 103 Rejections

The Examiner rejected each of the claims under 35 U.S.C. § 103(a) as being allegedly obvious over a combination of the McConnell patent (U.S. Patent No. 6,373,930) and one or more other references. Applicant submits that these § 103 rejections should be withdrawn, because McConnell is disqualified as prior art under 35 U.S.C. § 103(c).

At the time the present invention was made, both the present invention and the McConnell patent application were commonly owned or subject to an obligation of assignment to the same person. In particular, at the time the present invention was made, both the McConnell patent application and the present invention were assigned or subject to an obligation of assignment to Sprint Spectrum L.P. The cover page of the issued McConnell patent states that the McConnell patent was assigned to Sprint Communications Company L.P., which is 100% owned by the owner of Sprint Spectrum L.P. and would therefore constitute the co-ownership required by 35 U.S.C. § 103(c) to disqualify the McConnell patent as prior art, according to "Example 1" set forth in M.P.E.P. § 702.02(l)(2)(I). However, the Patent Office assignment records show that the McConnell patent was assigned to Sprint Spectrum L.P., the same assignee as the present invention, which would equally disqualify the McConnell patent under 35 U.S.C. § 103(c).

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Since the McConnell patent is disqualified as prior art under 35 U.S.C. § 103(c), a *prima facie* case of obviousness of claims 1-25 does not exist. Consequently, Applicant submits that the obviousness rejections of the claims should be withdrawn.

5. Conclusion

For the foregoing reasons, Applicant submits that all of the claims are allowable. Therefore, Applicant respectfully requests favorable reconsideration and allowance of the claims.

Should the Examiner wish to discuss this invention with the undersigned, the Examiner is invited to call the undersigned at (312) 913-2141.

Respectfully submitted,

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